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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,991	09/24/2003	William J. Kyte	H1938-00036	9732

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EXAMINER

SZEKELY, PETER A

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/669,991

Applicant(s)

KYTE ET AL.

Examiner

Peter Szekely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: Air dryable polymeric resins do not exist. Neither do acrylic latex polymers. There are no non-polymeric resins in existence. Applicants' invention contains aqueous latices of acrylic polymers, that is aqueous emulsions of acrylate ester polymers, acrylic acid polymers, acrylamide polymers, acrylonitrile polymers, their copolymers, etc. For further discussion, see "Response to Arguments".
2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The subject matter of claims 26, 42, 44, 48-54 and 61 cannot be found in the written description part of the specification. The examiner is aware that the original claims are part of the original specification. That is why no new matter rejection was made. However, applicants have to insert the subject matter of claims 26, 42, 44, 48-54 and 61 into the description part of the specification.

Appropriate correction is required.

3. The amendment filed 6/27/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: "For example, the viscosity of the grout compound can be adjusted such that it is not less than about 240

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Poise (and preferably not more than about 880 Poise)." The change from centipoises to poises constitutes new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 31 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The change from centipoises to poises constitutes new matter.

6. Claims 1-66 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "at least 15% by weight of an air dryable polymeric resin" cannot be found in the original specification.

7. Claims 1-66 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for 15-70% by weight of polymeric resin (see paragraph 0050), does not reasonably provide enablement for at least 15% by weight of

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polymeric resin, that is 15-100% by weight of polymeric resin. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. At least 15% means 15-100%.

8. Claims 1-65 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Adding at least 15% by weight of an aqueous emulsion is meaningless unless the solid content is known. Since latices generally have a solid content of 30-70% by weight, the actual amount minimum amount of binder (polymer) to be added to the grout composition can vary from 4.5% to 10.5%. One of ordinary skill in the art would not know how much latex to add to the fillers in order to achieve the minimum acceptable cohesion. Furthermore, it would be extremely easy for somebody to legally infringe applicants' invention, since 7% of a 70% solids latex contains more binder than 15% of a 30% solids latex.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

10. Claims 1-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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11. Air dryable polymeric resins do not exist (claims 1, 2, 60 and 65). Neither do acrylic latex polymers (claims 24-26). There are no non-polymeric resins in existence. Resin and polymer are synonyms. In British English resin can mean rosin, but that does not apply here. Applicants' invention contains "acrylic polymer latices", that is aqueous emulsions of polymeric (meth)acrylate esters, polymeric (meth)acrylic acids, polymeric (meth)acrylamides, polymeric (meth)acrylonitriles or their copolymers, etc. There is no solvent in the resin (claim 66). The water does not dissolve the resin, it is only a carrier and it is not in the resin, it only surrounds it. The evaporation rate depends on the prevailing temperature. The expressions "less than about", "greater than about", "not more than about" and "not less than about" render claims 1, 2, 13, 14, 16, 17, 60 and 65 indefinite. Since resin and polymer are synonyms a resin cannot contain a plurality of polymers. For further discussion see "Response to Arguments".

***Claim Rejections - 35 USC § 103***

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 1, 6-19, 21, 22, 24, 25, 27, 28, 31-33 and 40-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caldwell et al. 6,103,360, in view of Dassetto et al. 2,895,325, Pfingsten et al. 3,785,568, Stern et al. 5,524,798 or Taylor 6,291,536.

14. Anticipating the removal of the new matter, the rejection imposed in the previous Office action is maintained.

***Response to Arguments***

15. Applicant's arguments filed 6/27/05 have been fully considered but they are not persuasive. The examiner is aware that applicants defined a polymeric resin in paragraph 0032 of the specification as a "fluid form of a polymer or a fluid precursor of a polymer that is polymerized to form a polymer". Furthermore, the examiner knows that applicants can be their own lexicographers. However, where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "air dryable polymeric resin" in claims 1, 2, 60 and 65 is used by the claim to mean "an aqueous emulsion of a polymer", while the accepted meaning is "polymeric latex." The term is indefinite because the specification does not clearly redefine the term. A polymer does not have to be a fluid, as a matter of fact, most polymers are solids. "Resin" and "polymer" are synonyms; therefore the expression "polymeric resin" is as redundant as wet water. When water is evaporated from a latex, the polymer dispersed in it does not cure, it only agglomerates and forms a film. An acrylic latex is not a polymer, it is the dispersion (emulsion) of a polymer in water. Polymers are not divided into latex polymers and non-latex polymers. While "acrylic latex polymer" might be commonly used in the vernacular, it is incorrect. It defines an acrylic polymer, also called an acrylic resin, dispersed (emulsified) in water; therefore it is an acrylic

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polymer(ic) (resin) latex. The expression "air dryable polymeric latex" is also acceptable. There might or might not be a solvent in the latex, but water is not a solvent. Polymers of acrylic and methacrylic esters, which are the most common ingredients of acrylic latices, are insoluble in water. As far as the rejections of claims 1, 2, 13, 14, 16, 17, 60 and 65 are concerned, applicants are absolutely right. There is nothing wrong with "about". There is nothing wrong with "less than" or "greater than" or "not more than" or "not less than" either. But it is either "about" or "greater than", "less than", "not more than", etc. About 6.5 is fine. Greater than 6.5 is okay. However greater than about 6.5 is indefinite.

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.




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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (571) 272-1124. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Peter Szekely  
Primary Examiner  
Art Unit 1714

P.S.  
7/22/05

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